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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,538

03/17/2004

Brian Labrec

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,538	Applicant(s) LABREC, BRIAN	
	Examiner Patrick D. Niland	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008 and 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/4/08</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The amendments of 6/20/08 and 10/28/08 have been entered. Claims 1-15 and 26 are pending.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 9-10 of copending Application No. 10/677,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the explanation given in paragraph 4 of the office action mailed 12/8/06 which is incorporated here by reference. It is not seen that the method steps of composition claim 26 distinguish the composition of the copending claims from that of claim 26 of the instant application. Since the additives of the copending claims and the instant claims appear to be used for the same purposes, it is expected that they must be used in the same amounts. No unexpected results are seen for the instantly claimed amounts in a manner commensurate in scope with the instant claims and the cited prior art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is noted that the copending claims have been allowed but not yet issued in a patent.

Applicants state that they are going to defer response on the above double patenting rejection until issuance of at least one of the applications involved.

It is noted that until such issuance, the above rejection is maintained against the present claims.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed “second laser enhancing additives”, does not reasonably

provide enablement for all of the encompassed laser enhancing additives. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The scope of the claims read on all potential “second laser enhancing additive[s]” including those not disclosed by the enabling specification. Therefore the claims encompass all possible “second laser enhancing additive[s]”. The instantly claimed “second laser enhancing additive[s]” reads on an infinite number of compounds. In re Wands has 8 criteria, (MPEP 2164.01(a)), as shown below.

(A)The breadth of the claims;

(B)The nature of the invention;

(C)The state of the prior art;

(D)The level of one of ordinary skill;

(E)The level of predictability in the art;

(F)The amount of direction provided by the inventor;

(G)The existence of working examples; and

(H)The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is noted that the instant claims read on all potential “second laser enhancing additive[s]” which encompasses an infinite number of compounds (Wands factor A). The specification does not describe how to make all such “second laser enhancing additive[s]”, how to add them to the claimed compounds, nor how to select those “second laser enhancing additive[s]” from the infinite list

thereof which will function as required in the instant invention (Wands factors F, G). It would require an infinite amount of experimentation to determine how to make all of the “second laser enhancing additive[s]” encompassed by the instant claims and another infinite amount of experimentation to determine which of these “second laser enhancing additive[s]” would function in the instantly claimed invention as required (Wands factor H). Chemistry is an unpredictable art (Wands factor E). The ordinary skilled artisan has not imagined nor figured out how to make all of the “second laser enhancing additive[s]” encompassed by the instant claim of “second laser enhancing additive[s]” yet (Wands factors C, D, E, F, G, and H). The enabling disclosure is not commensurate with the full scope of the claimed “second laser enhancing additive[s]”.

The above rejection clearly rejects the claims. Clearly if a component of a composition is not fully enabled, that carries over to the whole composition. One would point out in patent examination that which is specifically not fully enabled and it would appear clear to all that if a single component of a composition is not fully enabled, as in this instance, that that enablement would clearly carry over to the whole invention. It would certainly not occur otherwise.

See *Sitrick v Dreamworks, LLC* (Fed Cir, 2007-1174, 2/1/2008), particularly

“Before MICHEL, Chief Judge, RADER and MOORE, Circuit Judges.
MOORE, Circuit Judge.”

112(1) Enablement - The enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation

We review the grant of summary judgment *de novo*. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed. Cir. 2007). Summary judgment is appropriate “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that

the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). Whether a claim satisfies the enablement requirement of 35 U.S.C. § 112, ¶ 1 is a question of law, reviewed de novo, based on underlying facts, which are reviewed for clear error. AK Steel Corp. v. Sollac, 344 F.3d 1234, 1238-39 (Fed. Cir. 2003). The evidentiary burden to show facts supporting a conclusion of invalidity is one of clear and convincing evidence because a patent is presumed valid. Id. The “enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” Id. at 1244.

112(1) Enablement - The full scope of the claimed invention must be enabled.
A patentee who chooses broad claim language must make sure the broad claims are fully enabled.

The full scope of the claimed invention must be enabled. See Auto. Techs. Int’l, Inc. v. BMW of N. Am., Inc., 501 F.3d 1274, 1285 (Fed. Cir. 2007). The rationale for this statutory requirement is straightforward. Enabling the full scope of each claim is “part of the quid pro quo of the patent bargain.” AK Steel, 344 F.3d at 1244. A patentee who chooses broad claim language must make sure the broad claims are fully enabled. “The scope of the claims must be less than or equal to the scope of the enablement” to “ensure[] that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.” Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195-96 (Fed. Cir. 1999).”

The above rejection performs the operations as required by the MPEP to make the above determination. It is further supported by the cited case law. Arguments that the examiner focused on only part of the invention and not the invention as a whole is not persuasive because if part is not enabled, as is the instant case, the whole containing the unenabled part cannot be enabled. Similar arguments relating to what enabled the claimed limitation were considered in the above cited case law and were not persuasive. The applicant’s arguments in this regard are not persuasive for the reasons stated above and in the cited case law. The above rejection did not establish the above test, the cited case law did, including in re Wands. Applicant’s to the contrary and regarding what the MPEP and law require are rebutted by the above cited case law

and In re Wands, as it is described in the MPEP. The applicant is directed to Sitrick v. Dreamworks, cited above.

The applicant's arguments have been fully considered but are not persuasive for the above reasons, which specifically or inferentially rebut the applicant's arguments. This rejection is therefore maintained.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4-6, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear if the weight percentages of claims 4-6 and 10 are based on all of the recited components in the compositions, all of the components in the composition, including those encompassed by "comprising", or some portion of the compositions such as the first and second laser enhancing additives only.

The applicant's argument that the punctuation in amended claim 1 leaves no doubt that the host material is not included in the first laser enhancing additive does not address the issues in this rejection, which are clearly cited directly above. The above claims are directed to compositions, which means that claims referenced in this rejection may read on all components in the compositions including those included by comprising or some subset thereof. It is unclear because the basis of the amounts of these claims is not specified. It is improper to read limitations into the claims from the specification. The applicant's claim interpretation is merely

further evidence of the lack of clarity of the instant claims, which fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention regarding the amounts of the claims subject to this rejection.

The applicant's arguments have been fully considered but are not persuasive for the above reasons, which specifically or inferentially rebut the applicant's arguments. This rejection is therefore maintained.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US Pat. No. 5840142 Stevenson et al., US Pat. No. 5374675 Plachetta et al., and US Pat. No. 5075195 Babler et al..

The cited prior art is all directed to marking polymer compositions with high energy sources though Stevenson does not disclose laser marking. The prior art is seen as being analogous therefore.

Stevenson discloses the instantly claimed compositions containing the instantly claimed polymers and pigments including barium or cadmium sulfides (column 3, lines 6-8) except that they do not contain the instantly claimed copper potassium iodide nor copper iodide.

Plachetta discloses laser inscribable compositions of the instantly claimed polymers, copper iodides (column 3, lines 60-61), and pigments (column 3, lines 32-54), which fall within

the scope of the instantly claimed compound of claim 7 of the instant application due to the affect of said pigments on light by definition of pigment, but no metal sulfides. The compounds of column 3, lines 32-56 are all expected to fall within the scope of the instant claim 7 also since some enhanced property is expected from each additive or it would not have been used.

Babler discloses laser marking compositions containing the instantly claimed polymers, molybdenum disulfide, pigments, and additives used in the plastics art, including additional colorants and antioxidants and heat stabilizers (column 4, lines 44-55), except that they do not contain the instantly claimed copper potassium iodide nor copper iodide.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the copper iodide of Plachetta with the compositions of Stevenson and/or Babler because the copper iodide would have been expected to give its antioxidant and/or heat stabilizing affects to the compositions of Stevenson and/or Babler and Stevenson and/or Babler encompass the use of such auxiliaries as stated above. The amount of Plachetta, column 3, lines 57-66 fall within the scope of the instant claims 1, 4-6, and 9-10. It is not seen that the processing steps of the instant claims give a different composition than that of the prior art discussed above. See MPEP 2112-2113. It is not seen that the above discussed polymeric compositions do not necessarily have the instantly claimed abilities of the instant claims 3, 11-12, and 14-15 due to the polymers used therein. Column 4, lines 35-36 of Babler implies the step of the instant claim 13.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the metal sulfide pigments of Stevenson and/or Babler in the compositions of Plachetta because they are broadly encompassed by Plachetta's disclosure

of using pigments and would have been expected to give their known pigmenting properties to the final compositions of Plachetta.

Since the laser marking of Plachetta will give heat and/or oxidation necessarily and inherently due to the energy of the laser that can mark polymer, heat stabilization and antioxidation clearly has something to do with laser inscribing. This argument of the applicant is not material in any event since Plachetta in fact discloses the use of these compounds in compositions which are to be laser inscribed. Applicant's arguments regarding use of copper iodide in Plachetta do not overcome the fact that Plachetta in fact discloses the use of these compounds in compositions which are to be laser inscribed. The teaching away argument cannot overcome this because Plachetta has not teaching away disclosures and teaches the use of the copper iodide. These arguments are not persuasive for this reason.

Arguments to the copending application's reference to antioxidants etc. are not persuasive because that application is not under examination here and Plachetta teaches the actual use of the copper iodide in compositions to be laser inscribed. The instant claims are directed to compositions, not laser inscribing grey scales argued by the applicant. There is not teaching that the laser inscribing of greyscales cannot be done on any of or the combinations of the prior art compositions. It is particularly expected that it can given the disclosure of laser inscribing the compositions of Plachetta and Babler and because this limitation is seen as having much to do with the technique of laser inscribing as with the compositions to be inscribed. The applicant provides not probative evidence that the above discussed composition would not be laser inscribable with the gray scale as claimed.

The above rejection meets the requirements of *Graham v. Deere*, with the pertinent factors being specified in the above rejection. See MPEP 2141, particularly the KSR decision therein. The examiner disagrees with what the applicant alleges the ordinary skilled artisan to consider regarding antioxidants and heat stabilizers verses laser enhancing additives for the reasons stated above regarding Plachetta.

The rationale to use the components of Stevenson in laser encribed compositions of the instant claims is found in Plachetta and Babler as noted above. Applicant's arguments in this regard are therefore not persuasive.

The applicant has demonstrated no unexpected results stemming from the instantly claimed compositions over the prior art cited in a manner commensurate in scope with the cited prior art and the instant claims.

The argued KSR decision is seen as supporting the instantly claimed rejection, particularly in view of the above stated reasons for combining the cited prior art. See MPEP 2141.

The applicant's arguments have been fully considered but are not persuasive for the above reasons, which specifically or inferentially rebut the applicant's arguments. This rejection is therefore maintained.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to 3 whose telephone number is 571-272-1121. The examiner can normally be reached on 4-10 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick D Niland/
Primary Examiner

Art Unit 1796